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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/817,141      | 03/27/2001  | Aya Imada            | 35.G2764            | 7091             |

5514 7590 02/27/2004

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

DUVERNE, JEAN F

ART UNIT PAPER NUMBER

2839

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/817,141

Applicant(s)

IMADA, AYA

Examiner

Jean F. Duverne

Art Unit

2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-34 is/are allowed.
- 6) ☒ Claim(s) 16-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 16-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshinaga et al (US patent 4,989,943) in view of Japan patent application (61-59303).

Yoshinaga's device discloses a plastic fiber (10) including a core and a cladding at 104; a lens (12) for controlling the light rays having a spherical light condensing lens. The lens is being integrated with the plastic optical fiber by heating and pressing the lens at high temperature (heating) and the use adhesive material with bonding features. The lens is formed with glass. The optical fiber with the outer sleeve is smaller than the lens (see fig. 20, a device (22) that is used as a substrate to hold the lens and the optical fiber. However, Yoshinaga's device fails to explicitly disclose the glass material that the lens is made of and the lens being at least partially embedded in the end face of the plastic material. JP patent (61-59303) discloses and the lens being at least partially embedded in the end face of the plastic material. It would have been obvious at the time the invention was made to one having ordinary skill in the art to least partially embed in order to meet the system specification and requirement. It would also have been

obvious at the time the invention was made to one having ordinary skill in the art to use the lens with thermally-softening temperature higher than a thermally softening temperature than the optical core fiber, since it has been held to within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter to meet design requirement. In re Leshin, 125 USPQ 416. It would also have been obvious at the time the invention was made to one having ordinary skill in the art to use the lens with thermally-softening temperature higher than a thermally softening temperature than the optical core fiber in order meet the system specification and requirement.

### ***Response to Amendment***

2. Applicant's arguments filed with the amendment on 11/28/2003 have been fully considered but they are not fully persuasive. The claims 16-28 do not define "structural structure features" that distinguish over prior art: Yoshinaga's device discloses a plastic fiber including a core and a cladding at 104; a lens (12) for controlling the light rays having a spherical light condensing lens. The lens is being integrated with the plastic optical fiber by heating and pressing the lens at high temperature (heating) and the use adhesive material with bonding features (see rejection above. Furthermore, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of a primary and secondary references. In re Nomiya, 184

USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the combination must be expressly articulated. The test for combining references is what the combination would suggest to one skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). Reference are evaluated by what they suggest to one versed in the art, rather than by specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. Nonetheless, the examiner agrees with applicant's argument about the steps not being recited in Yoshinaga's device: **Claims 29-34 are now allowed.** Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

Claims 29-34 are allowed over prior art based on applicant argument (see page 8, lines 13-20).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Duverne whose telephone number is (571) 272-2091. The examiner can normally be reached on 9:00-7:30, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on (571) 272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action may be mailed to:**  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, VA 22313-1450**

For additional information regarding this new address, which was effective May 1, 2003, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

**Or Faxed to:**  
**(703) 872-9306.**

**Hand-delivered responses** should be brought to:  
Crystal Plaza 4, Fourth Floor (Receptionist)

Application/Control Number: 09/817,141

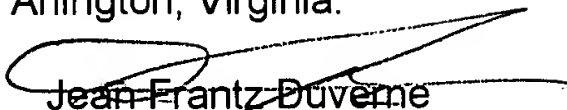
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Art Unit: 2839

2201 South Clark Place, Arlington, Virginia.

JFD

02/22/2004

  
Jean-Franz Duvene  
Primary Examiner  
Art Unit 2839